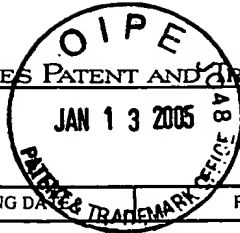




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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/345,202	06/30/1999	DAVID A. MARTIN	0236.0006	9944

7590

01/23/2003

Daniel A. Thomson & Brouse McDowell  
500 First National Tower  
Akron, OH 44308-1471

EXAMINER

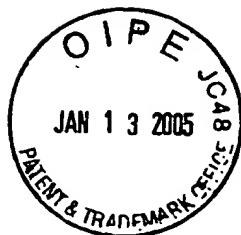
AKERS, GEOFFREY R

ART UNIT PAPER NUMBER

3624

DATE MAILED: 01/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



4/23/2003

SL

## Office Action Summary

Application No. <b>09/345202</b>	Applicant(s) <b>Martin</b>
Examiner <b>Akers, g</b>	Group Art Unit <b>3624</b>

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- ☒ Responsive to communication(s) filed on 12/2/02
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 111; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1, 6-12, 14-15, 20, 23 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1, 6-12, 14-15, 20, 23 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or requirement.

### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

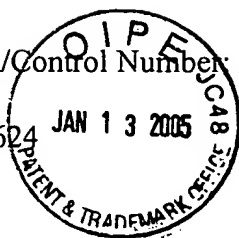
### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application
- ☐ Other \_\_\_\_\_



## DETAILED ACTION

### *Response to Request for Continued Examination*

1. This action is issued in reply to applicant's Request for Continued Examination(RCE)(Paper #16) filed 12/2/02.
2. Claims 2-5,13,16-19,21,22 were cancelled.Claims 1,6-8,10,14,20,23 were amended.No new claims were added.
3. Claims 1,6-12,14-15,20,23 as amended, are pending.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 USC 103(a) as unpatentable over Hayosh(US Pat. No: 6,212,504) in view of Schrader(US Pat. No: 5,903,881).
6. Claim 1 is rejected under 35 USC 103(a) as unpatentable over Hayosh(US Pat. No: 6,212,504) in view of Carney(US Pat. No: 5,367,148).
- 7.(AMENDED) As per claim 1, Hayosh teaches a method for preventing check fraud, the method comprising the steps of providing a bank with a bank routing number and providing a customer having an account with the bank and a corresponding account number(Fig 1) having the customer

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electronically create a check containing at least, a payee, an amount, a date, a customer name, and a check number(Fig 1). Hayosh teaches attaching a bar code on the check(Fig 1) using electronic placement means wherein the bar code contains the customer's account number, the bank's routing number and at least one piece of information selected from the group consisting of, the payee, the amount, the date, the customer's name, and the check number(col 11 line 11-col 14 line 22). Carney teaches delivering the check to the bank and scanning the bar code and, paying the check only if the information printed on the check is identical to the at least one piece of information on the bar code(col 4 lines 5-38). It would have been obvious to one skilled in the art at the time of the invention to combine Hayosh in view of Carney to teach the above. The motivation to combine is to teach a system for fraud prevention for checks as enunciated by Carney(col 2 lines 45-48).

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8. Claims 10-11,20 are rejected under 35 USC 103(a) as unpatentable over Royer(US Pat. No: 6,195,452).

9.(AMENDED)As per claim 10, Royer teaches a method for preventing fraud, the method comprising the steps of providing a drawer having an account with a corresponding account number(Fig 1/80B) providing a drawee with a drawee routing number(Fig 1/80A) providing means for creating a negotiable instrument(Abstract) creating at least one negotiable instrument containing at least a payee(Fig 1/30) an amount(Fig 1/40) a date(Fig 1/70), and a drawee's identity(Fig 1/30) providing a machine readable code and attaching the machine readable code on

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the at least one negotiable instrument, the machine readable code containing the drawer's account number(Fig 4/600) the drawee's routing number(Fig 1/80A) and at least one piece of information selected from the group comprising, the payee, the amount, the date, the identity of the drawer, a memo, and a identifier number corresponding to the at least one negotiable instrument(Fig 4/500).Royer does not specifically teach one of the above elements but instead teaches fields for a check verity code(col 7 lines 23-45). It would have been obvious to one skilled in the art at the time of the invention to include identity or a memo in the field for identification purposes. The motivation for this is to establish a fraud detection system for checks.

10. (AMENDED)As per claim 11 Royer teaches the method of claim 10, wherein the method further comprises the steps of the drawee receiving the at least one negotiable instrument and scanning the machine readable code(Fig 4).

11.(AMENDED) As per claim 20 Royer teaches a method for integrating the creation and processing of negotiable instruments, the method comprising the steps of providing a drawer having an account with a corresponding account number(Fig 1/80B) providing a drawee with a drawee routing number(Fig 1/80A) creating at least one negotiable instrument containing information that contains at least, a payee(Fig 1/50) an amount(Fig 1/40) a date(Fig 1/70) and a drawee's identity(Fig 1/60) providing a machine readable code and attaching the machine readable code on the at least one negotiable instrument(Fig 4/90a-90j) the machine readable code containing the drawer's account number(Fig 1/80A/80B), the drawee's routing number and at least one piece of information selected from the group comprising, the payee, the amount me

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date, the identity of the drawer, a memo, and a identifier number corresponding to the at least one negotiable instrument(Fig 4/500).Royer does not specifically teach one of the above elements but instead teaches fields for a check verity code(col 7 lines 23-45). It would have been obvious to one skilled in the art at the time of the invention to include identity or a memo in the field for identification purposes. The motivation for this is to establish a fraud detection system for checks.

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12. Claims 6,7-9,12,14 are rejected under 35 USC 103(a) as unpatentable over Carney(US Pat. No: 6,181,814) in view of Schrader(US Pat. No: 6,195,452).

13.(AMENDED) As per claim 6 Carney teaches a method for preventing fraud, the method comprising the a drawee(Abstract)(Fig 1) providing a drawer having an account with the drawee and a corresponding account number(Fig 1) and delivering to the drawee at least one negotiable instrument drawn to the drawer's account(Fig 1). Carney fails to teach putting the at least one negotiable instrument into an electronic format to be viewed on the Internet and viewing the at least one negotiable instrument on the Internet and having the drawer advise the drawee which of the at least one negotiable instruments to pay.Schrader teaches this(Abstract)(Fig 1)(Fig 5).It would have been obvious to one skilled in the art at the time of the invention to combine Carney in view of Schrader to apply these methods to the Internet. The motivation for this is to provide an online banking software product that integrates account management as enunciated by Schrader(col 5 lines 48-57).

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14.(AMENDED) As per claim 7 Carney teaches the method of claim 6. Carney does not specifically teach wherein putting the at least one negotiable instrument into an electronic format to be viewed on the Internet comprises the steps of: entering the information from the negotiable instrument into an electronic database and linking the electronic database with the drawer's account. Schrader teaches this(Fig 4)(Fig 5)(Fig 7)transferring information from the electronic database to the Internet.It would have been obvious to one skilled in the art at the time of the invention to combine Carney in view of Schrader to teach the above and to apply this methodology to the internet as an automation of existing technology.The motivation for this is to provide an online banking software produict that integrates account management as enunciated by Schrader(col 5 lines 48-57).

15. (AMENDED) As per claim 8 Carney teaches the method of claim 6. Carney does not specifically teach wherein viewing the at least one negotiable instrument on the Internet comprises the steps of determining if any of the at least one negotiable instruments were created by the drawer and electronically marking any of the at least one negotiable instrument that were created by the drawer and viewing the instrument on the Internet and transferring information from the electronic database to the Internet.Schrader teaches this(Abstract)(Figs 1-7).It would have been obvious to one skilled in the art at the time of the invention to combine Carney in view of Schrader to teach the above and to apply this methodology to the internet as an automation of existing technology.The motivation for this is to provide an online banking software product that integrates account management as enunciated by Schrader(col 5 lines 48-57).

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16. As per claim 9 Carney teaches the method of claim 8, wherein the method further comprises the step of paying the at least one negotiable instrument that the drawer has advised the drawee to pay(col 2 lines 49-col 3 line 2).

17. As per claim 12, Carney teaches the method of claim 11, wherein the method further comprises the steps of the drawee of determining whether information printed on the at least one negotiable instrument is identical to the at least one piece of information on the machine readable code; and, paying the negotiable instrument only if the information on the machine readable code is identical to the at least one piece of information on the at least one negotiable instrument(col 2 line 49-col 3 line 2).

18.(AMENDED) As per claim 14, Carney teaches the method of claim 13, wherein after scanning the machine readable code, the method comprises the step of automatically comparing the information on the at least one negotiable instrument to the information in the drawee database(col 4 line 66-col 5 line 65)(col 4 lines 16-24).

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19. Claims 15, 23 are rejected under 35 USC 103(a) as unpatentable over Carney(US Pat. No: 6,181,814) in view of Schrader(US Pat. No: 6,195,452) and further in view of Royer(US Pat. No: 6,195,452).

20. As per claim 15 Carney teaches the method of claim 12. Carney does not teach specifically wherein determining whether information printed on the at least one negotiable instrument is identical to the at least one piece of information on the machine readable code comprises the step



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of notifying the drawer if the information printed on the at least one negotiable instrument is not identical to the at least one piece of information on the machine readable code. Royer teaches this(Fig 4)(col 9 lines 30-52).It would have been obvious to one skilled in the art at the time of the invention to combine Carney in view of Schrader to teach the above and to apply this methodology to the internet as an automation of existing technology.The motivation for this is to provide an online banking software product that integrates account management as enunciated by Schrader(col 5 lines 48-57). It would also have been obvious to one skilled in the art at the time of the invention to combine Carney in view of Schrader and further in view of Royer to teach the above and to apply this methodology to the internet as an automation of existing technology.The motivation for this is to provide an improved method for detecting the authenticity of negotiable instruments as enunciated by Royer(col 1 lines 48-52).

21.(AMENDED) As per claim 23 Carney teaches according to the method of claim 22. Carney does not specifically teach the following but Royer teaches wherein the method further comprises the steps of providing an integrated system, wherein the drawee and the drawer's creation of the at least one negotiable instrument are linked(col 2 lines 20-63) whereby when the at least one negotiable instrument is created(Fig. 1), the information is stored in a drawee database and providing means for the drawer to view the drawer's account(Fig 1/80A/80B). Royer teaches accepting or rejecting checks based on validity(Fig 4/900).It would have been obvious to one skilled in the art at the time of the invention to combine Carney in view of Schrader to teach the above and to apply this methodology to the internet as an automation of

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existing technology. The motivation for this is to provide an online banking software product that integrates account management as enunciated by Schrader (col 5 lines 48-57). It would also have been obvious to one skilled in the art at the time of the invention to combine Carney in view of Schrader and further in view of Royer to teach the above and to apply this methodology to the internet as an automation of existing technology. The motivation for this is to provide an improved method for detecting the authenticity of negotiable instruments as enunciated by Royer (col 1 lines 48-52).

#### ***Response to Arguments***

22. Applicant's arguments with respect to claims as amended have been considered but are moot in view of the new ground(s) of rejection.

#### ***Double Patenting***

23. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

24. Claims 1,6-8,10,14,20,23 are rejected under the judicially created doctrine of double patenting over claims 1-14 of U. S. Patent No. 6,390,362 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as the claims do not appear to be patentably distinct.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Conclusion***

25. **THIS ACTION IS MADE NON-FINAL.**


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26. Any questions concerning this communication should be addressed to the examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday at (703)-306-5844. If attempts to contact the examiner are unsuccessful, the examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 2100 or this Art Unit is (703)-308-6296 or 6306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-305-3900.

GRA

  
January 21, 2003

**Attachment for PTO-948 (Rev. 03/01, or earlier)  
6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.